

## REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application in view of the amendments and the remarks to follow. Claim 38 has been amended, claims 1-36 and 40-49 were previously canceled and new claims 50-61 have been added. Claims 37-39 and 50-61 are pending in this application. Entry of the amendments and reconsideration of the application are requested in view of the amendments and the remarks to follow.

The amendments to the specification update related application data, address minor informalities noted during review and/or bring the drawings and specification into mutual conformance. No new matter is added by the amendments to the specification.

The amendment to claim 38 addresses minor informalities noted during review and is not intended to alter the scope of the claims. No new matter is added by the amendment to claim 38.

New claims 50-61 are supported at least by text appearing at page 4, line 2 through page 46, line 15 of the substitute application, which corresponds to the application as originally filed. New claims 50 et seq. are similar to claims 37-39 but differ in scope. No new matter is added by new claims 50 et seq. New claims 50 et seq. distinguish over the art of record and are allowable.

### 35 U.S.C. § 102

Claims 37-39 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,587,129 B1 to Lavendel et al. (hereinafter "Lavendel"). Applicant respectfully disagrees and requests reconsideration.

Anticipation is a legal term of art. Applicant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the reference must include every element of the claim within the four corners of the reference (see MPEP §2121); (ii) the elements must be set forth as they are recited in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be modified (see MPEP §706.02, stating that "No question of obviousness is present" in conjunction with anticipation); and (iv) the reference must enable the invention as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions must be simultaneously satisfied.

The §102 rejection of claims 37-39 is believed to be in error. Specifically, the PTO and Federal Circuit provide that §102 anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

No §103 rejection has been lodged regarding claims 37-39. Accordingly, if Applicant can demonstrate that Lavendel does not disclose any one claimed element with respect to claims 37-39, the §102 rejections must be withdrawn, and

a subsequent non-final action made with a different rejection in the event that the Examiner still finds such claims to be not allowable.

Applicant notes the requirements of MPEP §2131, which states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM." This MPEP section further states that "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

Lavendel is directed (see, e.g., Title) to a "user interface for image acquisition devices". Lavendel describes (see Abstract): "A user interface for image acquisition devices that provides common control of common features of different image acquisition devices while retaining the flexibility needed to provide tailored control that take advantage of unique features of each different image acquisition device. The user interface includes a control area for displaying a property sheet. The property sheet has a plurality of property pages, each of which has an interface for image acquisition device control and each of which has a tab describing the control provided by that property page. At least one property page has an interface for core image acquisition device control, and at least one

property page has an interface for device-dependent image acquisition device control. The user interface also provides a property sheet with a property page that attractively provides plural interfaces for control in that property page. The property page includes a control region for providing control and a button region having multiple buttons. An appearance of the control region is changed in response to user manipulation of the multiple buttons, with each different appearance providing a different interface for the control."

In contrast, claim 37 recites "An application program interface for an image acquisition system, the application program interface being embodied on a computer-readable medium and having methods for performing the following functions: creating a device object for an imaging device; displaying a user interface to enable a user to choose the device object; displaying a user interface to enable the user to capture an image using the imaging device; and querying the imaging device for properties", which is not taught or disclosed by Lavendel.

The Office Action states (p. 2, continuing on p. 3) that "Lavendel teaches querying the imaging device for properties (col. 3, lines 8-67; col. 4, lines 1-40)." Applicant respectfully disagrees for reasons that are explained below in more detail.

These passages variously describe:

a common interface for common features of different image acquisition devices, while retaining flexibility needed to tailor the interface for unique features of different imaging devices (col. 3, line 8 et seq.);

a user interface provided by a TWAIN data source (line 26 et seq.);

a user interface that includes a property sheet with a plurality of pages (line 32 et seq.), whereby the user may select a property page (line 44 et seq.);

a user interface that controls an image acquisition device (line 52 et seq.);

a user interface with multiple buttons arranged based on user familiarity with or complexity of the different interfaces resulting from user manipulation of the multiple buttons (col. 4, line 12 et seq.);

an aspect whereby the appearance of a property page is changed so as to provide plural different interfaces (line 27 et seq.).

These passages are silent with respect to any "application program interface" having "methods for performing" any function of "querying the imaging device for properties", as recited in claim 37. They merely provide different user modalities for accessing and displaying information already contained within the computing system or in a TWAIN data source and for image manipulation. The TWAIN data source is explicitly described (col. 5, line 56 et seq.) as a fixed disc 6 or CD-ROM associated with the computer system 1. Operation of the TWAIN data modules is described in more detail with reference to Fig. 2 et seq.

In particular, Fig. 3 and col. 6, line 49 et seq. describe user-selectable options on a menu 32 which "includes a list of available TWAIN data sources" (lines 52 and 53) such as "IMAGE ACQUISITION DEVICE 52", "IMAGE ACQUISITION DEVICE A", "IMAGE ACQUISITION DEVICE B" etc. (Fig. 3, menu 32). In other words, Lavendel teaches user selection from a predetermined list of devices for which property information is obtained from a canned or preprogrammed data source external to any imaging device, and does not teach or disclose "querying *the imaging device* for properties", as recited in claim 37.

Indeed, Applicant has explicitly stated (specification, page 1, line 18) that "TWAIN lacks robustness and interoperability" and that (line 20 et seq.) "Accordingly, a task set before the inventor was to create an image acquisition system that was *based on an open architecture model* and could be integrated with existing applications and operating systems to provide a convenient environment for the user." As such, Lavendel fails to even comprehend the problems addressed by the claimed subject matter and cannot possibly provide the solutions encompassed thereby.

Amended claim 38 recites "An application program interface for an image acquisition system, the *application program interface* being embodied on a computer-readable medium and *having methods for* performing the following functions: opening and closing a camera for communication; controlling the camera; *reading properties associated with the camera*; reading properties associated with pictures taken by the camera; and manipulating pictures stored in a memory of the camera", which is not taught or disclosed by Lavendel. A detailed description of functions for, e.g., inspecting the image device properties from the device is provided in the specification at page 15, line 6 et seq.

Claim 39 recites "An application program interface for an image acquisition system, the *application program interface* being embodied on a computer-readable medium and *having methods for* performing the following functions: opening and closing a scanner for communication; controlling the scanner; and *reading properties associated with the scanner*", which is not taught or disclosed by Lavendel.

The anticipation rejection of claims 37-39 thus fails the tests noted above. As a result, the anticipation rejection of claims 37-39 is clearly prima facie defective and should be withdrawn, and claims 37-39 should be allowed.

**Conclusion**

Claims 37-39 and 50-61 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: Dec 31, 2003

By: 

Frederick M. Fliegel  
Reg. No. 36,138  
(509) 324-9256 x239